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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,732	12/21/2000	Waldemar Kiener	(K) 54 039	6906

7590 09/18/2002
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EXAMINER

GOFF II, JOHN L

ART UNIT	PAPER NUMBER
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1733

9

DATE MAILED: 09/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/746,732

Applicant(s)

KIENER ET AL.

Examiner

John L. Goff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 13-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I, claims 1-12, in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 62 (first mentioned on page 11, line 4). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuhaus et al. (U.S. Patent 4,389,472) in view of Ueda et al. (EP 726142) and the admitted prior art (Specification pages 1-2).

Neuhaus et al. are directed to a method of forming tamperproof documents (documents that cannot be falsified such as credit cards, company cards, etc.) by laminating an information carrier with a plastic foil on one or both sides wherein the plastic foil has an adhesive layer that is hardened by UV radiation (Column 1, lines 5-7 and 53-66 and Column 7, lines 33-35 and Column 12, lines 31-37). Neuhaus et al. teach an information carrier (the carrier may include a photo-polymer film) continuously laminated on one or both sides with a plastic foil (the foil includes a layer of UV curable adhesive) to form a laminate (Column 10, lines 30-43 and

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Column 11, lines 17-26). The laminate is then exposed to UV radiation to cure the adhesive (Column 11, lines 53-56). Neuhaus et al. teach that the plastic foil is fed from a supply roll, the foil may be comprised of polyethylene, and the foil is subjected to a corona discharge prior to lamination (Column 9, lines 49-50 and Column 10, lines 3-10 and Column 11, lines 28-30). Neuhaus et al. are silent as to using an information carrier provided on each side with a protective film (supporting film). However, it is known in the art that to provide a protective film on one or both sides of the information carrier during manufacturing as shown by the admitted prior art and Ueda et al. Furthermore, it is known in the art to remove the protective film prior to applying the carrier to a substrate as shown by the admitted prior art and Ueda et al. One of ordinary skill in the art at the time the invention was made reading Neuhaus et al. in view of the admitted prior art and Ueda et al. would have readily appreciated incorporating into Neuhaus et al. an information carrier with a protective film provided on one or both sides wherein the film is removed prior to processing as suggested by the admitted prior art and Ueda et al. as only the expected results would be achieved.

The admitted prior art is directed to known processes for producing forgery proof documents. The admitted prior art teaches that information carriers comprising polymer films are provided with protective films (supporting films) on both sides during their production (Specification page 2, lines 1-5). It is noted it appears that the admitted prior art suggests that removing the protective films prior to processing into forgery proof documents was known at the time the invention was made (Specification page 2, lines 7-13). However, in any event it was known to do so as shown by Ueda et al. Ueda et al. are directed to a method for producing a photosensitive film laminate that includes a hologram. Ueda et al. teach providing the

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photosensitive film with a protective film (Figure 6b and Column 8, lines 31-36). Ueda et al. teach that the protective film is removed from the laminate prior to applying the hologram on a substrate (Column 9, lines 31-38).

Regarding claims 1 and 2, it would have been within the purview of one of ordinary skill in the art at the time the invention was made to process each side of the film separately (removing the protective film from one side of the information carrier prior to applying a polymer film with a layer of UV curable adhesive and then removing the protective film from the other side of the information carrier prior to applying a polymer film with a layer of UV curable adhesive to that side of the information carrier as shown in Figure 2) or together (remove both protective films prior to applying both polymer films each including a layer of UV curable adhesive as shown in Figure 3) as only the expected results would be achieved.

Regarding claims 5 and 6, the use of a roller to transport the laminate during curing wherein the laminate is wrapped around the roller by at least 180° is known in the art as shown by Ueda et al. (35 of Figure 6a), and one of ordinary skill in the art at the time the invention was made would have readily appreciated using the roller to transport the laminate as only the expected results would be achieved.

7. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuhaus et al, the admitted prior art, and Ueda et al. as applied above in paragraph 6, and further in view of Butler et al. (U.S. Patent 3,822,838).

Neuhaus et al., the admitted prior art, and Ueda et al. teach all of the limitations in claims 10 and 11 except for a teaching on using a splicer and a storage device to ensure the continuous supply of photo-polymer (information carrier) film. It is noted, Ueda et al. teach forming the

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photo-polymer film on a supply roll (43 of Figure 6a). Butler et al. are directed to an apparatus for providing an uninterrupted supply of a web material from a supply roll to a machine that consumes the web at a high speed (Column 1, lines 7-10). Butler et al. teach that the apparatus comprises a splicer to automatically splice in a new roll when the running roll is depleted and an accumulator to ensure the web is continuously supplied to the web consuming machine when a new roll is being spliced (Figure 1 and Column 1, lines 10-21). One of ordinary skill in the art at the time the invention was made would have readily appreciated incorporating into the method taught by Neuhaus et al. as modified by the admitted prior art and Ueda et al. the splicer and storage device taught by Butler et al. to ensure a continuous supply of photo-polymer film.

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Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **703-305-7481**. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



John L. Goff
September 17, 2002



Michael W. Ball
Supervisory Patent Examiner
Technology Center 1700